THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EAMONN HOBBS and WILLIAM APPLING

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Appeal No. 96-3203
Application No. 08/081,984[1]

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ON BRIEF

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Before McCANDLISH, Senior Adminstrative Judge, STAAB, and McQUADE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 21 through 31, 33 and 34 under 35 U.S.C. § 102(b). The only other claims still pending in the

[1] Application for patent filed June 23, 1993. According to appellants, this application is a continuation-in-part of Application 08/004,635 filed January 12, 1993, now abandoned; which is a continuation of Application 07/846,142 filed March 5, 1992, now abandoned.

application have been withdrawn from consideration as being directed to a nonelected invention.

The claimed invention relates to a non-permanent blood clot filter which is adapted to be inserted into a blood vessel. The filter is formed from a single high memory coiled wire having a cylindrical segment (14b) and a conical segment (14a).[2] According to claim 21, the only independent claim on appeal, the cylindrical segment extends from a first end (16) of the coiled wire to an "intermediate position," and the conical segment extends from the intermediate position to the second end (18) of the coiled wire.

A copy of the appealed claims is appended to appellant's brief.

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[2] The cylindrical and conical segments are described in the specification as cylindrical and conical portions.

The following reference is relied upon by the examiner as evidence of anticipation in support of his rejection under 35 U.S.C. § 102(b):

German Patent (Heinke)[3] 3,203,410 Nov. 25, 1982

Claims 21 through 31, 33 and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Heinke.

The Heinke reference discloses a helically coiled wire that is adopted to be placed in a blood vessel for sealing the blood vessel. According to Heinke's specification, the coiled wire may have a "cylindrical, conical or barrel-shaped form" (translation, pages 3-4). The conical embodiments are shown in Figures 5 and 6 of the Heinke reference. From the examiner's response to appellants' arguments on page 6 of the answer, we understand that he relies on the conical embodiment shown in Figure 6 of the Heinke reference.

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[3] A translation of this reference is attached to the examiner's answer.

Appellants do not appear to dispute the examiner's position that Heinke's device "is capable of performing in the same manner as Applicant's [sic, applicants'] device" as set forth on page 3 of the answer. In support of this position, the examiner relies on Heinke's disclosure that the coiled wire will "inhibit the blood flow to a high degree" thus inferring that some blood will flow past the coiled wire to filter the blood. We nevertheless cannot sustain the § 102(b) rejection of claim 21.

Contrary to the examiner's position as set forth on page 3 of the answer, Heinke does not disclose that the "largest loop is cylindrical" in the embodiment shown in Figure 6 or, for that matter, the other conical embodiment shown in Figure 5. Instead, the coiled wires shown in both of these embodiments are merely described as being "conical," thus inferring that the coiled wire has a spiral form in which the diameter of the coiled wire continuously and progressively decreases from the base end to the apex of the coiled configuration. In contrast, a loop or segment thereof would be required to have a constant diameter in

order to be considered as having a “cylindrical” form. From Heinke’s description that the embodiments shown in Figures 5 and 6 are conical, it cannot be assumed that the largest turn or loop or even a segment thereof has a constant diameter to assume a cylindrical configuration.

The barrel-shaped embodiments shown in Figures 7 and 8 also fail to anticipate the subject matter of appealed claim 1 because the cylindrical portion in each of these barrel configurations lies intermediate the ends of the coiled wire and thus does not extend from one end of the wire as required by claim 1. Obviously, Heinke’s cylindrical embodiments of Figures 3 and 4 also fail to anticipate the subject matter of claim 1 because they lack the claimed conical segment.

Since each and every element of appealed claim 21 is not expressly or inherently disclosed in Heinke, this reference does not anticipate the subject matter of claim 21. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ. 385, 388 (Fed. Cir. 1984).

The examiner's decision rejecting claims 21 through 31, 33 and 34 is therefore reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)

HEM/jlb

Lloyd McAulay
McAulay Fisher Nissen Goldberg & Keil
261 Madison Avenue
New York, NY 10016